

Application No.: 10/074,992

REMARKS

The Office Action of April 7, 2005 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Claim 1 is amended to clarify that the invention is an apparatus for disinfecting operatory unit water as set forth, for example, in ¶ [0005] of the as-published application. Claims 5 – 6, 12 – 13, 16, 19, 20, 23, 25, 27 – 28 and 30 – 31 have been amended to clarify the limitations set forth therein, and in particular to eliminate the recitation of method terminology and characterize such limitations in relation to the apparatus claims from which they depend. No new matter was added by the amendments, as the limitations are consistent in scope with that which was previously set forth.

Turning now to the office action, claims 5 – 6, 12, 16 – 17, 19 – 20, 23, 25, 27 and 30 – 31 were rejected under 35 USC §112, second paragraph, as being indefinite (use of method terminology and objected term “operatory”). Claims 1 – 16, 18 – 28 and 30 – 31 were rejected under 35 USC §102(b) as being clearly anticipated by Burris (5,207,993). Claims 17 and 29 were rejected under 35 USC §103(a) as being unpatentable over Burris '993 as applied to claims 1 – 16, 18 – 28 and 30 – 31 and further in view of Viebahn (5,158,454).

Considering the rejection under 35 USC §112, second paragraph, claims 5 – 6, 12 – 13, 16, 19, 20, 23, 25, 27 – 28 and 30 – 31 have been amended to clarify the limitations set forth therein, and in particular to eliminate the recitation of method terminology and characterize such limitations in relation to the apparatus claims from which they depend. Applicants respectfully submit that the “method terminology” has been recharacterized in the amended claims as particular limitations associated with recited elements of the claimed device. In the event the rejection is maintained, Applicants respectfully request that the Examiner set forth those elements that continue to be objected to as indefinite.

As to the use of the term “an operatory,” Applicants respectfully urge that an operatory is a well-known term of art in various medical professions, particularly including dentistry. Applicants interpret the Examiner's rejection as stemming from the use of the term “an operatory” in a claim in which antecedent basis has previously been set forth for “an operatory unit.” Accordingly, claim 23 is amended to

Application No.: 10/074,992

refer to "the operatory unit," and is believed, therefore, to overcome any vague or indefinite meaning for the term.

Alternatively, if the Examiner objects to Applicant's general use of the term "operatory," Applicants urge that such a term would be understood to include those pieces of equipment found in a dentist's or surgeon's patient treatment area – where medical and dental operations are performed. For example, in the dental profession it is well known that operatory equipment may include chairs, lights, dental units, sterilizers, and handpieces, and that some equipment employs water. In the event that the Examiner requires further information relative to the well-known use of the term "operatory," Applicants respectfully reserve the right to submit documents from, for example, the American Dental Association (www.ada.org) or other professional organizations and trade journals as evidence of such common usage and meaning of the term.

Claims 1 – 16, 18 – 28 and 30 – 31 were rejected under 35 USC §102(b) as being anticipated by Burris '993. Burris '993, identified by Applicants, is directed to equipment for purifying batches of liquid with ozone. One example is the treatment of saline solution in an optometrist's office (col. 2, lines 40 – 43). The process of purification consumes ozone - when the liquid is allowed the time for purification to take place then a substantial amount of the dissolved ozone is consumed and is not available to also disinfect surfaces that it contacts. Thus, Burris '993 does not appear to disclose the output of a disinfecting liquid.

Conversely, the present invention is a continuous system for disinfecting operatory unit water and lines. Claim 1 specifically recites a device for disinfecting operatory unit water, wherein the device includes a circulation system that circulates liquid containing dissolved ozone through a pressurized liquid circulation loop connected to the operatory unit. In addition to being connected to an operatory unit, the device further provides pressurized liquid containing ozone to the operatory unit – thereby permitting disinfection of the water and lines. Applicants respectfully urge that such limitations have not been identified within Burris '993. In light of the apparent failure to teach all limitations set forth in claim 1, Applicants respectfully urge that claim 1, and all claims dependent therefrom, cannot be anticipated by Burris '993. Hence, the rejection of claims 1 – 16, 18 – 28 and 30 – 31 is respectfully traversed and an indication of the allowance of all claims is requested.

Application No.: 10/074,992

Insofar as claims 2 - 31 are concerned, these claims all depend from now presumably allowable amended claim 1, and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim 1 and as further set forth below.

Turning next to the rejection under 35 USC §103(a), claims 17 and 29 were rejected as being unpatentable over Burris '993 as applied to claims 1 - 16, 18 - 28 and 30 - 31 and further in view of Viebahn. Applicants respectfully submit that the rejection fails to establish where, in either of the references, there is a suggestion for the proposed combination or modification. Although such a combination might be argued to have been "within the purview of one skilled in the art" it is Applicants understanding that the references themselves must teach or suggest the proposed combination. It appears that the basis of combination has been urged to be a desire to "protect the ozone generator," yet no such teaching was cited in either Burris '993 or Viebahn. Accordingly, Applicants respectfully contend that a proper basis for the combination, other than the elements recited in the claims of the instant application, has not been provided and request that the rejection be withdrawn or that adequate basis be set forth to which Applicants may respond.

Considering, *in arguendo*, the asserted combination of Burris '993 in view of Viebahn, Applicants respectfully incorporate herein the arguments made relative to the traversal set forth above relative to claim 1. Viebahn appears to disclose an apparatus that ozonates tap water supplied to dental instruments for continuously disinfecting that water, and selectively converting the ozone therein to oxygen prior to discharge of the water. However, Applicants again note that no teaching has been identified, in either Burris '993 or Viebahn, relative to the recited limitation in claim 1 of a circulation system that circulates the liquid containing dissolved ozone through a pressurized liquid circulation loop connected to the operatory unit. Accordingly, claims 17 and 29, both including the limitations of claim 1, are also patentably distinguishable over the arguable combination.

Furthermore, claim 17 is dependent from claim 16, which recites the limitation that the circulation system discards liquid not output for use. Claim 17 further recites that the discarded liquid is directed to rinse a cuspidor. Although Viebahn appears to teach a cuspidor (expectoration bowl 17), the rejection fails to indicate where Viebahn teaches use of waste liquid for rinsing the cuspidor as is presently set forth

Application No.: 10/074,992

in claim 17. Relative to claim 29, Applicants respectfully note that the limitations of dependent claims 27 and 28 are also included within claim 29, and that the air pressure used to control a valved dispensing means is also employed to drive a turbine in a hand piece. Applicants do not believe that the rejection sets forth any teachings in which air pressure is described to control both the liquid valve and the hand piece as required by claim 29. Accordingly, claims 17 and 29 are further urged to be patentably distinguishable over the proposed combination of Burris '993 in view of Viebahn.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



Duane C. Basch
Attorney for Applicant
Registration No. 34,545

Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970

DCB/dcb